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In re Application of:	:	
DAVIDSON, Beverly, L., et al.	:	
U.S. Application No.: 10/522,954	:	DECISION ON PETITION
PCT No.: PCT/US2003/016887	:	FOR REVIVAL UNDER
International Filing Date: 26 May 2003	:	37 CFR 1.137(b) AND
Priority Date: 05 August 2002	:	PETITION UNDER
Attorney's Docket No.: 17023.045US2	:	37 CFR 1.48(b)
For: ALLELE-SPECIFIC siRNA-MEDIATED GENE	:	
SILENCING	:	

This decision is issued in response to applicants' "Petition for Revival Of Application" under 37 CFR 1.137(b) and "Request To Correct Inventorship Under 37 CFR 1.48(b)," filed 04 December 2006. Applicants have submitted the required petition fees

BACKGROUND

On 26 May 2003, applicants filed international application PCT/US2003/016887. The international application claimed a priority date of 01 May 2002, and it designated the United States. The deadline for filing the basic national fee was thirty months from the priority date, that is, 05 February 2005.

On 31 January 2005, applicants filed a Transmittal Letter seeking entry into the U.S. national stage accompanied by, among other materials, payment of the basic national fee.

On 08 December 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and sequence listing materials.

On 09 February 2006, applicants filed a response to the Notification Of Missing Requirements which included sequence listing materials, the small entity surcharge payment, and a declaration that named as inventors, and was executed by, only two of the five inventors of record.

On 21 March 2006, the DO/EO/US mailed a Notification Of Defective Response (Form PCT/DO/EO/916) indicating that the filed declaration was defective for failure to include all the inventors of record.

On 13 April 2006, applicants filed a response to the Notification Of Defective Response which asserted that the filed declaration should be accepted because the inventorship listed therein was correct, based on the preliminary amendment filed with the national stage papers.

On 08 August 2006, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a proper response to the Notification Of Missing Requirements mailed 08 December 2005.

On 04 December 2006, applicants filed the petition for revival under 37 CFR 1.137(b) considered herein accompanied by, among other materials, the "Request To Correct Inventorship Under 37 CFR 1.48(b)" also considered herein.

DISCUSSION

1. Petition For Revival Under 37 CFR 1.137(b)

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Applicant here has failed to satisfy item (1).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that "[g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed." Here, the "required reply" was a proper response to the Notification Of Defective Response mailed 21 March 2006, that is, an oath or declaration in compliance with 37 CFR 1.497.

The present petition is not accompanied by the required oath or declaration. Rather, applicants have submitted a "Request To Correct Inventorship Under 37 CFR 1.48(b)" seeking to correct the inventors of record herein to correspond to those set forth in the previously filed declaration. However, as discussed below, the inventorship of a U.S national stage application filed under 35 U.S.C. 371(c) cannot be corrected pursuant to 37 CFR 1.48(b) until after applicants have satisfied the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) by, among other things, filing an acceptable oath or declaration executed by all the inventors of record in the international application.

Since applicants' present submission is insufficient to correct the inventorship herein to correspond to the previously filed declaration, the "required reply" of an oath or declaration acceptable under 37 CFR 1.497 has not been filed; item (1) above is therefore not satisfied.

Because applicants have failed to satisfy all the requirements of a grantable petition, revival of the application on the present record is not appropriate.

2. **Request To Correct Inventorship Under 37 CFR 1.48(b)**

By its express terms, 37 CFR 1.48(b) applies only to "non-provisional" applications. As set forth in 37 CFR 1.9(a)(3), a national stage application filed under 35 U.S.C. 371 is not considered a "non-provisional" application until "after compliance with 35 U.S.C. 371." Applicants here have not filed a declaration executed by the inventors of record in the international application, as required by 35 U.S.C. 371(c)(4). Accordingly, applicants' request to correct the inventorship herein pursuant to 37 CFR 1.48(b) is premature, and must be held in abeyance pending revival of the application and satisfaction of the requirements of 35 U.S.C. 371(c).

The inventors of record remain the five inventors set forth in the international application.

CONCLUSION

Applicants' petition or revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

Applicants' request to correct inventorship under 37 CFR 1.48(b) is **HELD IN ABEYANCE** pending revival of the application and satisfaction of the requirements of 35 U.S.C. 371(c).

If reconsideration on the merits of the petition for revival is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and include the materials required to satisfy item (1) above.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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